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# 09/427,892    10/26/99    WEIFFEN

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EXAMINER

WILLIAMS, T

ART UNIT

PAPER NUMBER

3613

DATE MAILED:

05/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application N .

09/427,892

Applicant(s)

WEIFFEN ET AL.

Examiner

Thomas J. Williams

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 11, 2001 have been approved.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter of having sole passage that communicates the working chambers is not disclosed. The figures merely disclose that a *sole passage through the piston* communicates the working chambers. Figure 1 in fact illustrates a passage exterior to the working chambers, the significance of this passage is not disclosed by the applicant. The addition of the claimed feature to the specification would be considered a new matter situation.

The examiner will interpret the claims to imply that a sole passage through the piston communicates the working chambers.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 5 recites the limitation "the actuator" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 3-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,850,461 to Rubel.

Re-claim 1, Rubel discloses a vibration damper, comprising: a working cylinder 6 filled with a damping medium; a piston 7 fastened to a piston rod 8 arranged in an axially movable manner in the working cylinder and dividing the cylinder into two working spaces 15 and 16; first 22 and second 23 non-return valves are arranged in the piston for respectively providing a damping force for rebound and compression directions of the vibration; a damping valve 26 arranged in the piston having a variable damping action and arranged in series with each of the first and second non-return valve, thereby acting in both the rebound and compression directions of the vibration damper, wherein the damping valve in series with the first and second non-return valves comprises a sole passage (through the piston) for the damping medium between the two working spaces such that the damping fluid is required to flow through the damping valve when

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the damping fluid is exchanged between the two working spaces in the rebound and the compression directions of the vibration damper.

Passage 20 is the sole passage during a compression action of the damper. Passage 21 is the sole passage during a rebound condition of the damper.

Re-claim 2, the damping valve comprises an externally activated actuator for adjusting the variable damping valve.

Re-claims 4 and 5, a characteristic of the damping valve is precontrollable in either the rebound or compression direction. The actuator device comprises an electrically controlled valve, which will have an electromagnet. The damping valve is positioned by the controller 47 into either a passive or active mode, and is thus considered precontrollable.

Re-claim 6, the first and second non-return valves are accommodated together with their associated valve seats in the piston.

Re-claim 7, the first and second non-return valves are preassembled with their associated valve seats as a modular unit and are fixedly connected in the piston.

Re-claim 8, the first and second non-return valves and the damping valve are arranged in the piston.

Re-claim 9, the first and second non-return valves communicate with one of the upper and lower working spaces and the damping valve actuates a flow connection to the other of the upper and lower working spaces. Each non-return valve communicates directly with one chamber and communicates via the damping valve with another chamber.

Re-claim 10, the damping valve comprises a valve body that is precontrollable to a precontrolled setting in one of the rebound and compression directions and directly controllable

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via an actuator in the other of the rebound and compression directions. The damping valve is positioned by the controller 47 into either a passive or active mode, and is thus considered precontrollable.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubel in view of US 3,726,368 to Taylor.

Rubel fails to disclose at least one of the non-return valves comprising a spring loaded valve disk, but rather the use of ball check valves as the non-return valves. Taylor teaches that it is known in the art to utilize spring loaded plate type valve in place of a spring biased ball valve, see column 1 lines 64-68. It would have been obvious to one of ordinary skill in the art to have utilized a spring loaded valve disk in place of the ball valve as taught by Taylor as the non-return

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valve in the device of Rubel, this would have reduced manufacturing costs and time since the valve disks can be attached externally to the piston.

12. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,533,597 to Nezu et al.

Re-claim 1, Nezu et al. discloses a vibration damper with a variable damping force, comprising: a working cylinder 11; a piston 15; first 23 and second 24 non-return valves; a damping valve 25 in series with the first and second non-return valves. However, Nezu et al. further discloses the use of secondary passages communicating the working chambers. It is the position of the examiner that the damper is operational without passages 17 and 18. It would have been obvious to one of ordinary skill in the art to have simply removed passages 17 and 18 in the device of Nezu et al., this would have reduced the manufacturing costs of the damper.

Re-claim 2, the damping valve is externally activated.

Re-claim 3, Nezu et al. teaches the use of spring loaded disc valves.

Re-claims 4 and 10, the damping valve is adjusted to provide a desired damping and is therefore viewed as being precontrollable.

Re-claim 5, an actuator 29 is electrically operated and will have electromagnets.

Re-claims 6-8, the non-return valves are accommodated and preassembled with their respective seats in the piston, and fixedly connected in the piston.

Re-claim 9, the first and second non-return valves communicate with one of the upper and lower working spaces and the damping valve actuates at least one flow connection to the other of said upper and lower working spaces.

***Response to Arguments***

13. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

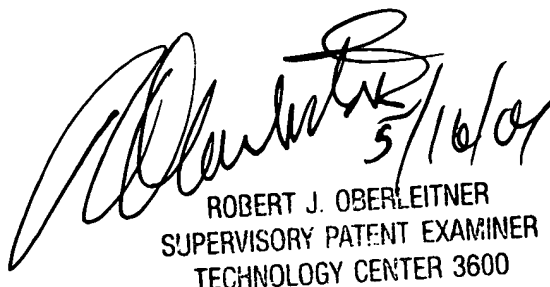
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 61-075008 and JP 6-024228 each disclose a vibration damper with a variable damping force. Grun et al. ('803) discloses a vibration damper with a variable damping force.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

TJW

May 15, 2001

  
5/16/01  
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